

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendment and in view of the response which follows.

In the present Action, claims 13-16 are pending. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented with an appropriate defined status identifier. The amendment does not go beyond the original disclosure of the application.

Applicants have amended claim 13 to remove the improperly amended format under 37 C.F.R. 1.121(c). This objection is thereby rendered moot.

In the current Action, the Examiner has maintained his obviousness-type double patenting rejection of: (a) claims 13-16 over claims 32, 34, 42, 45, 48, 71, 82-87, 90-91 and 93-94(a)(iv) of co-pending Application No. 08/359,938 (the '938 application); and (b) claims 15 and 16 over the claims of U.S. patent No. 6,013,859 (the '859 patent).

As a point of clarification, the Examiner of the '938 application, upon issuance of a restriction requirement, withdrew claims 42, 45, 48, 90-91, and 93 from consideration (see Paper No. 14, mailed June 18, 1993). Accordingly, the only claims that could possibly be at issue are claims 32, 34, 71, 82-87 and 94(a)(iv).

In rejecting claims 13-16, the Examiner characterizes the Applicant's arguments as "disingenuous," reasoning that (a) "the requirement of a 3' untranslated terminator signal sequence is well-known in the art," (b) such a sequence "appears in a multitude of native genes," and (c) such a sequence "has been widely used in the genetic engineering art in constructing recombinant DNA molecules for transcription into sense and antisense transcripts...." The Examiner further asserts that such reasoning not only appear in the specification of the present application as part of the Applicants' admissions but also "appears in the specifications of the patent and of the co-pending application."

In determining whether an obviousness-type double patenting rejection is appropriate, "the disclosure of the patent may not be used as prior art." M.P.E.P. §804 (August 2001). Therefore, the Examiner's reference to the specification is improper. Applicants urge that in

the absence of the reference to the specification, the Examiner cannot establish a *prima facie* case of obviousness-type double patenting.

Rather to establish that a *prima facie* case in this regard, the Examiner must show that the invention defined in any claim in the present application is an obvious variation of subject matter claimed in the '859 patent or in the '938 application. Against this standard, Applicants respectfully submit that the Examiner has not met the PTO's burden with respect to claims 13-16. Applicants traverse these rejections.

As stated in the previous response, none of the cited claims discloses a 3' untranslated terminator signal sequence, an element that is required in each of the pending claims. Nor is there any suggestion in the cited claims to incorporate a terminator sequence, as presently recited, into a "recombinant DNA molecule" that is linked to a gene of either sort prescribed in claims 13 and 15, respectively. In the absence of such disclosure or suggestion, there is no merit to the Examiner's characterization of the presently claimed invention as an obvious variation of an invention claimed in the '859 patent or in the '938 application.

Applicants maintain, therefore, that the arguments presented in the previous Action are correct as a matter of law. Accordingly, a double patenting rejection should not be made over the disclosure of the '859 patent or the '938 application but rather on the claims thereof, which define the invention that is patented or to be patented.

CONCLUSION

Applicants thereby submit that the present application is in condition for allowance, and that no terminal disclaimer is needed. An early notice to this effect is earnestly solicited. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

Date

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By

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